

REMARKS

Claims 1 to 16 are pending in this application. Claims 1 to 6 are rejected and objected to. Claims 7 to 16 are withdrawn from consideration as directed to non-elected subject matter but are subject to rejoinder as a matter of right, if they depend from or otherwise include all the limitations of an allowed claim. Applicants are herein amending pending claims 1 to 3 and 5 and 6 and withdrawn claims 7 to 16.

Claim Amendments

Applicants are herein amending claim 1 to 3, 5, and 6, without prejudice or disclaimer, to delete non-elected subject matter. Applicants explicitly reserve the right to file one or more divisional applications to the non-elected subject matter.

Applicants are herein amending claim 5 to present it as an independent claim. Applicants are also herein amending claims 6 to 16 to present them as dependent claims from independent claim 1 and independent claim 5.

Applicants are herein amending claims 1 and 6 to correct obvious typographical errors.

Applicants are herein amending claims 1 and 2 to clarify that R_1 and R_9 are not H. In addition, applicants are herein amending claim 1 to clarify that R_4 is hydrogen. Applicants are herein amending claim 5 to delete compound c. Applicants explicitly reserve the right to file one or more continuing applications directed to the deleted subject matter.

Applicants submit that no new matter is added by the amendments to the claims. The amendments to the claims are fully supported by the application, as originally filed.

DOCKET NO.: AM100977 (WYNC-0809)
Application No.: 10/670,646
Office Action Dated: May 5, 2006

PATENT

Restriction Requirement

Applicants note that the Examiner has made the restriction requirement final. However, it is applicants understanding that method claims 7 to 16 are withdrawn from consideration, as directed to non-elected subject matter, but are subject to rejoinder, as a matter of right, if they depend from or otherwise include all the limitations of an allowed claim. Applicants are, therefore, showing claims 7 to 16 as withdrawn and currently amended to present them as dependent from independent claims 1 and 5, so that they are subject to rejoinder.

Claim Objections

Claims 1 to 6 are objected to as containing non-elected subject matter. Applicants are herein amending claims 1 to 3, 5, and 6 to delete the non-elected subject matter. Accordingly, applicants request withdrawal of the objection to claims 1 to 6.

Double Patenting

Claims 1 and 6 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 to 7, 9 to 11, 18, 19, 22 to 24, 26, 31, 32, and 50 of copending U.S. Patent Application 11/194263 (Published U.S. Application 2006/0030612). Applicants request that the provisional obviousness-type double patenting rejection be held in abeyance pending the indication of allowance of the claims.

Rejections under 35 U.S.C. § 102

Published US Application 2002/103229

Claims 1, 5, and 6 are rejected under 35 U.S.C. §§ 102(a)¹ and 102(e) as allegedly anticipated by Published US Application 2002/103229. Applicants are herein amending claim 1 such that R₁ and R₉ are not hydrogen and to delete compound c from claim 5. Accordingly, the compounds disclosed in Published US Application 2002/103229 do not anticipate claims 1, 5, and 6. Therefore, applicants request withdrawal of the rejections of claims 1, 5, and 6 under 35 U.S.C. §§ 102(a) and 102(e) as anticipated by Published US Application 2002/103229.

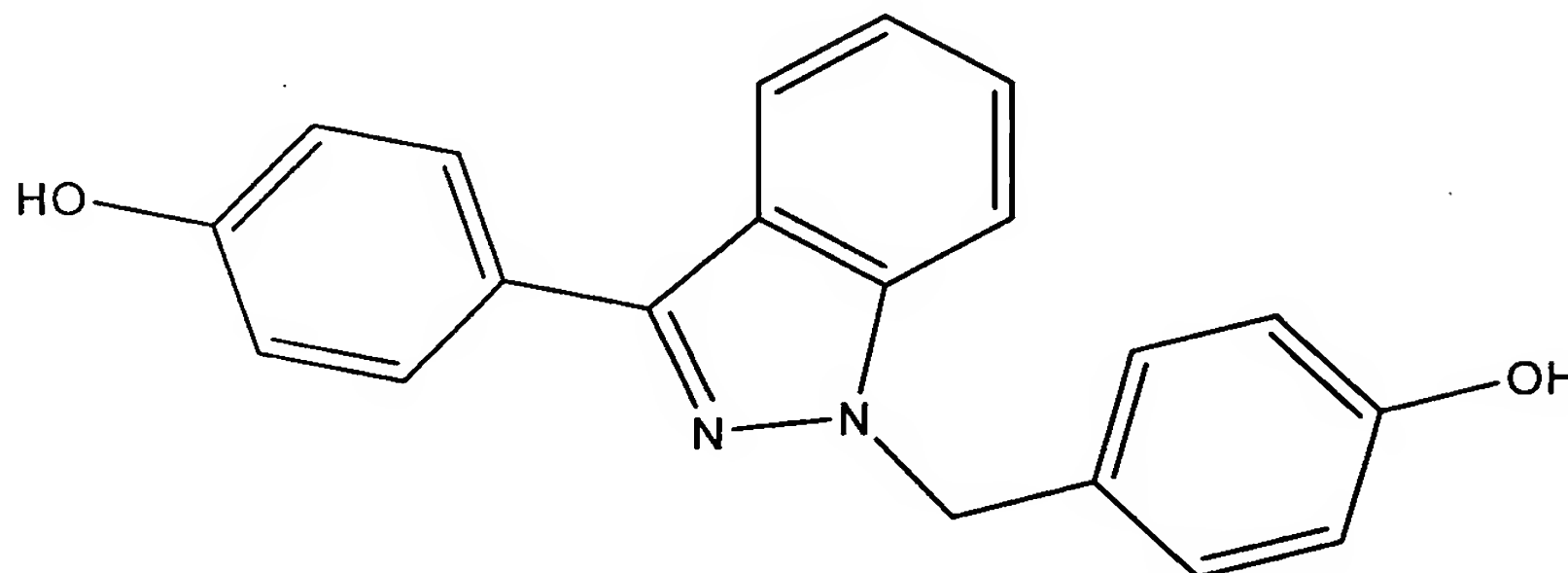
Stadlbauer Reference

Claims 1 and 2 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by the Stadlbauer reference. Applicants traverse the rejection because the Office has not established that the Stadlbauer reference is a valid reference under 35 U.S.C. § 102(a). For 35 U.S.C. § 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work. See M.P.E.P. § 706.02(a). Applicants' effective filing date is September 25, 2002, the filing date of the provisional application 60/413,931 to which the subject application claims benefit. Therefore, applicants' invention date is ***at least as early as September 25, 2002***. The Stadlbauer reference was published in 2002. However, no month and date are given. Thus, the Office has not even established that the reference was available before the latest possible invention date. Accordingly, applicants request withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. § 102(a).

¹Applicants do not concede that Published US Application 2002/103229 is a valid reference under 35 U.S.C. § 102(a).

CAS Registry No. 329279-69-2

Claim 1 is rejected under 35 U.S.C. § 102(b) as allegedly anticipated by CAS Registry No. 329279-69-2:



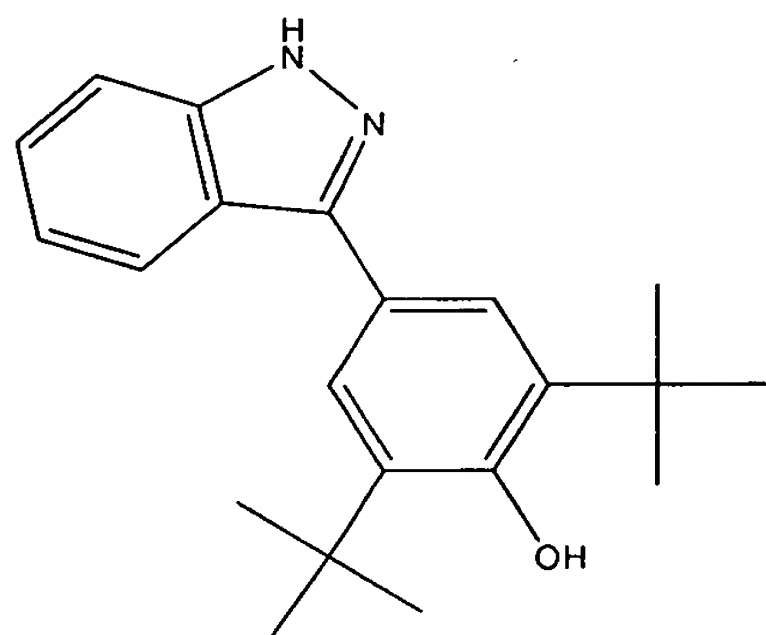
4[[3-(4-hydroxyphenyl)-1H-indazol-1-yl]methyl]-phenol

Applicants are herein amending claim 1 to clarify that it does not include compounds where R₉ is hydrogen. Because the R₉ may not be hydrogen, applicants submit that CAS Registry No. 329279-69-2 (where the moiety in the R₉ position is hydrogen) does not anticipate claim 1.

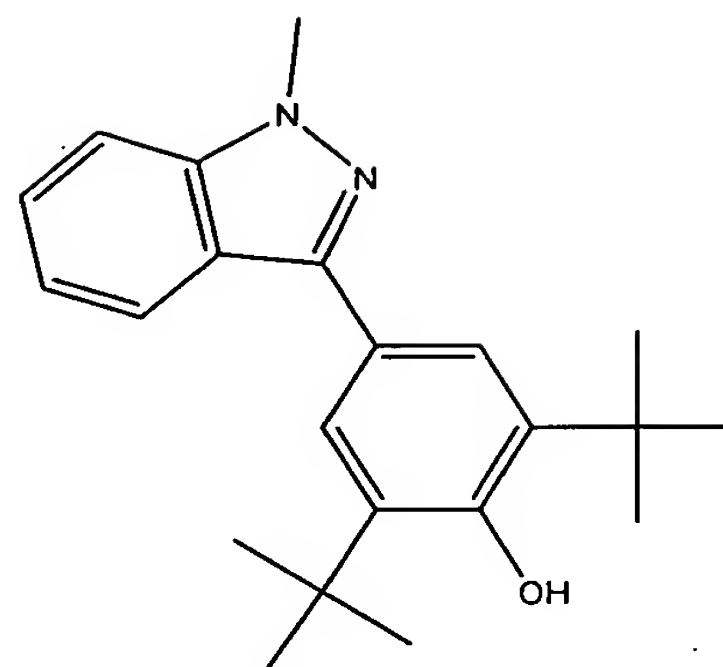
Accordingly, applicants request withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b) as allegedly anticipated by CAS Registry No. 329279-69-2.

JP 01180878 (Abstract)

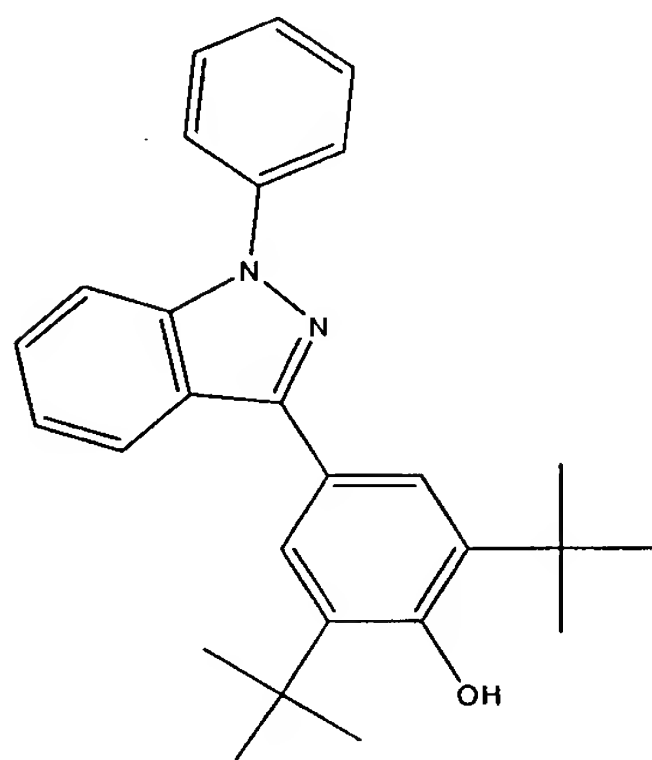
Claims 1, 2, and 6 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by several compounds in JP 01180878.



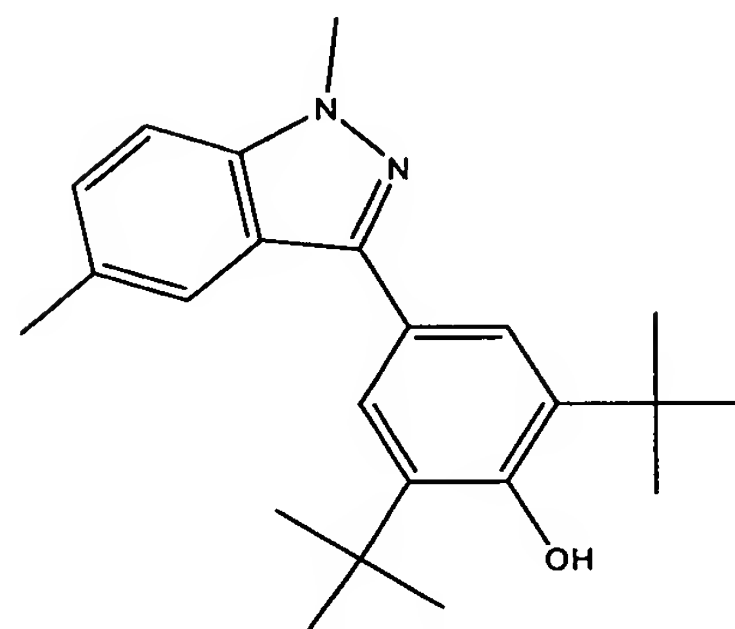
2,6-bis(1,1-dimethylethyl)-4-(1H-indazol-3-yl)-phenol



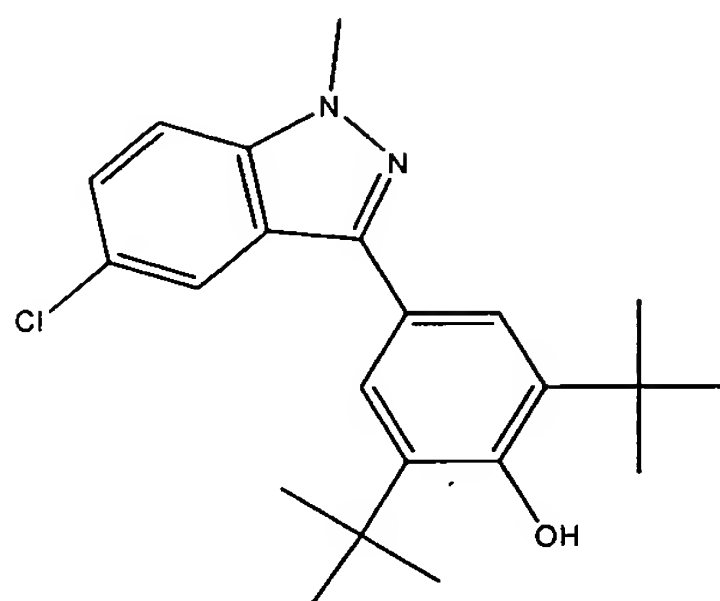
2,6-bis(1,1-dimethylethyl)-4-(1-methyl-1H-indazol-3-yl)-phenol



2,6-bis(1,1-dimethylethyl)-4-(1-phenyl-1H-indazol-3-yl)-phenol



2,6-bis(1,1-dimethylethyl)-4-(1,5-dimethyl-1H-indazol-3-yl)-phenol



4-(5-chloro-1-methyl-1H-indazol-3-yl)-2,6-bis(1,1-dimethylethyl)-phenol

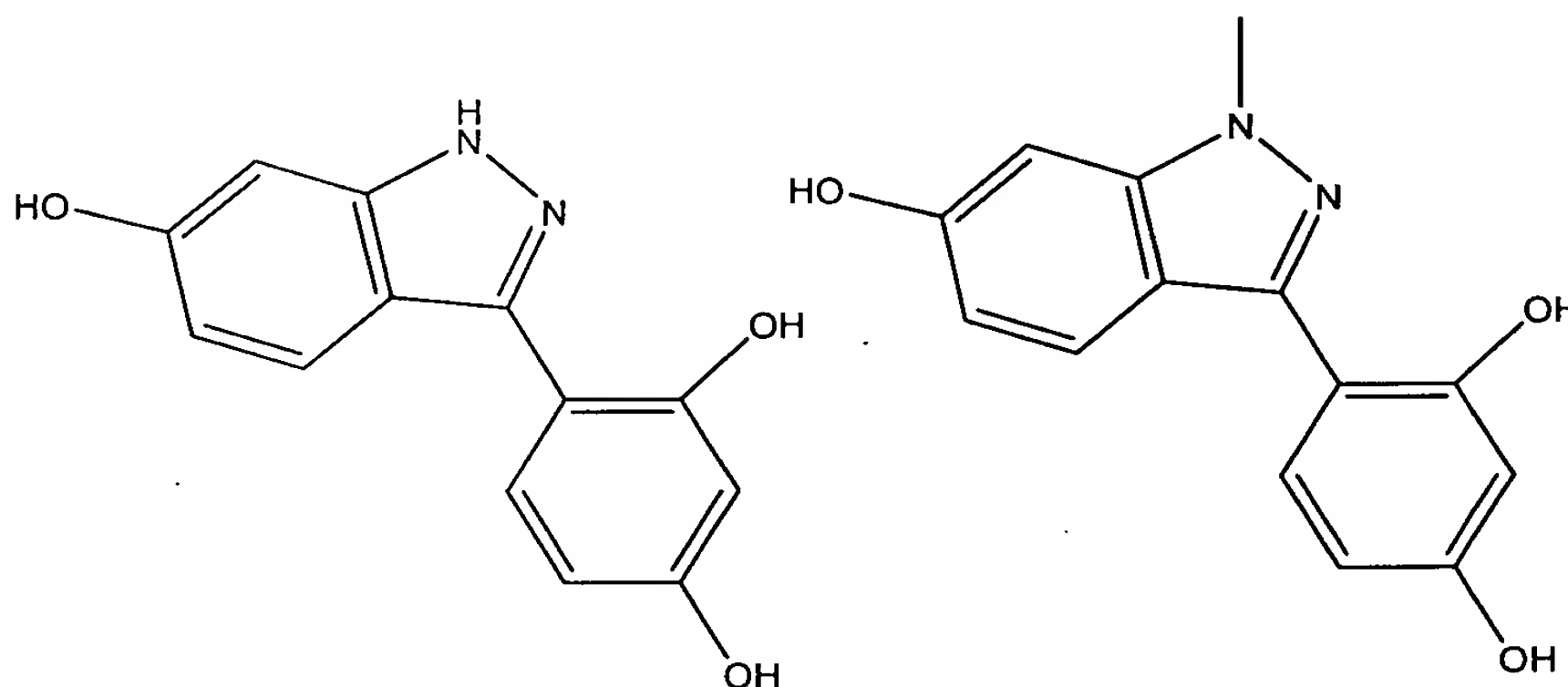
Applicants are herein amending claim 1 to clarify that it does not include compounds where R_1 and R_9 are hydrogen and only includes compounds where R_4 is hydrogen. Because neither R_1 or R_9 may be hydrogen and R_4 must be hydrogen, applicants submit that the

compounds disclosed in JP 01180878 (where the moiety in the R₉ position is hydrogen in each instance and R₄ is other than hydrogen) do not anticipate claim 1.

Accordingly, applicants request withdrawal of the rejection of claims 1, 2, and 6 under 35 U.S.C. § 102(b) as allegedly anticipated by JP 01180878.

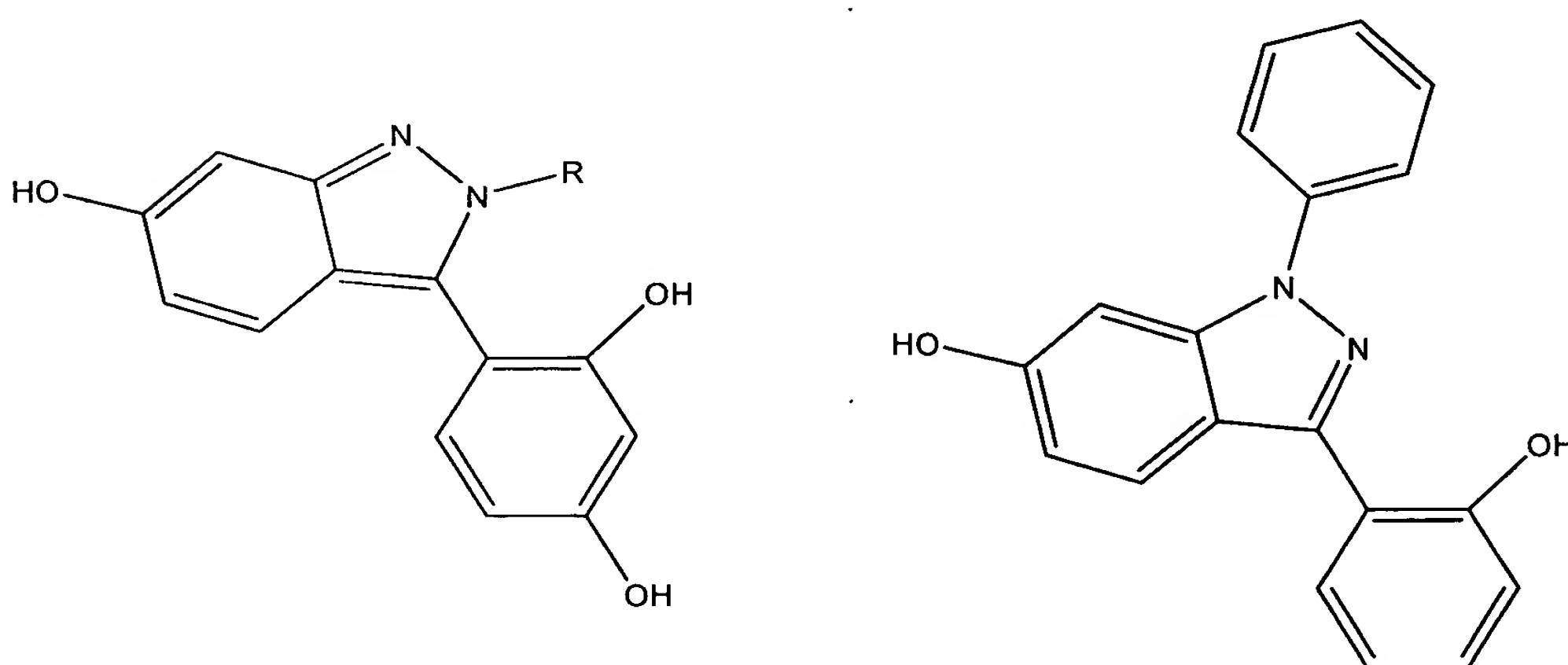
Krishnan Reference

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the compounds 6, 7, 7a, and 9 in the Krishnan reference.



Compound 6

Compound 7



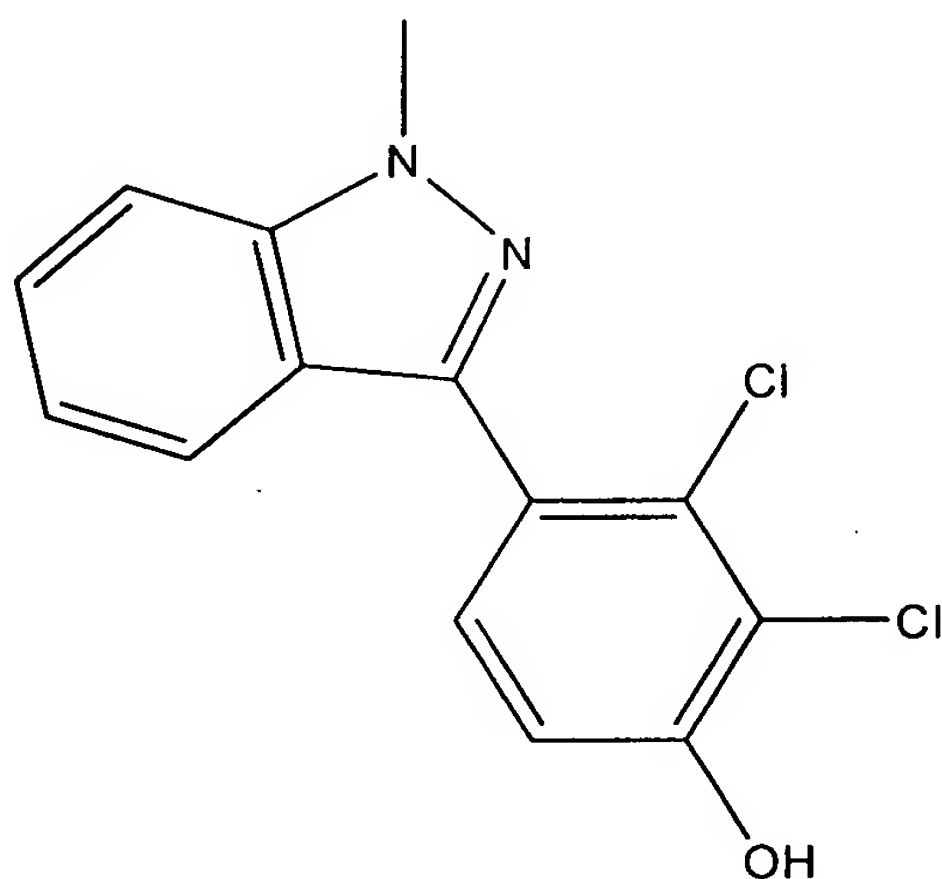
Compound 7a

Compound 9

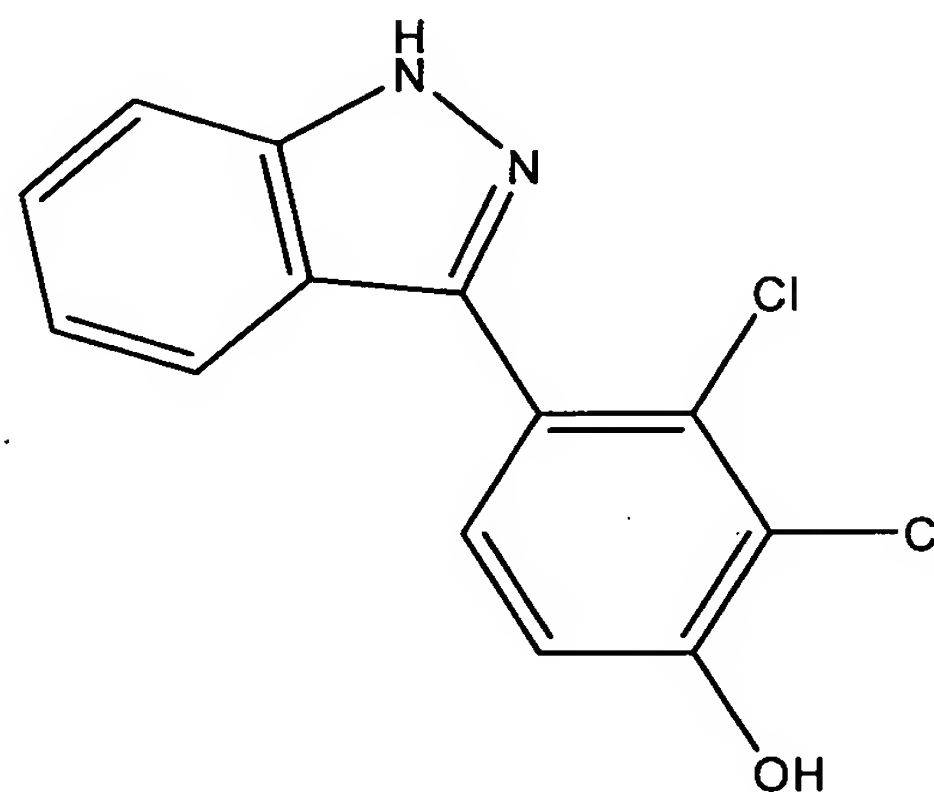
Applicants are herein amending claims 1 and 2 to clarify that it does not include compounds where R_9 is hydrogen. Because R_9 may not be hydrogen, applicants submit that the compounds disclosed in the Krishnan reference (where the moiety in the R_9 position is hydrogen in each instance) do not anticipate claims 1 and 2.

Shutske Reference

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by compounds 7a and 7b the Shutske reference.



Compound 7a



Compound 7b

Applicants are herein amending claim 1 to clarify that it does not include compounds where R_1 and R_9 are hydrogen and only includes compounds where R_4 is hydrogen. Because neither R_1 or R_9 may be hydrogen, applicants submit that the compounds disclosed in the Shutske reference (where the moiety in the R_9 position is hydrogen in each instance and R_4 is other than hydrogen) do not anticipate claims 1 and 2.

DOCKET NO.: AM100977 (WYNC-0809)
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PATENT

Rejection under 35 U.S.C. § 103

Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over several of the compounds disclosed in JP 01180878 (Abstract) because they are allegedly either positional isomers or hydrogen substitutions of the claimed compounds. Applicants traverse the rejection and do not concede that compounds of claims 3 and 4 are positional isomers of the compounds disclosed in JP 01180878. However, solely for the purpose of expediting prosecution, applicants are further limiting claim such that R₄ is limited to hydrogen.

Amended claim 1 (from which both claims 3 and 4 depend) is limited such that it does not include compounds where R₁ and R₉ are hydrogen and only includes compounds where R₄ is hydrogen. Thus, the compounds disclosed in JP 01180878 are clearly not positional isomers of the claimed compounds. Furthermore, a skilled artisan would not be motivated to substitute a hydrogen for a bulky *tert*-butyl moiety and expect similar activity due to steric considerations. Accordingly, applicants request withdrawal of the rejection of claims 3 and 4 under 35 U.S.C. § 103(a).

DOCKET NO.: AM100977 (WYNC-0809)
Application No.: 10/670,646
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PATENT

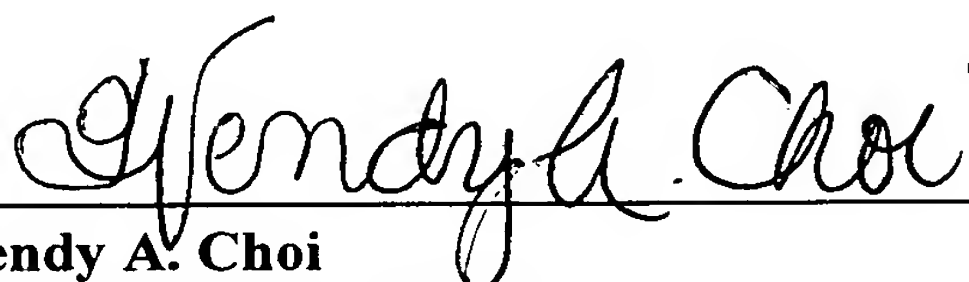
Conclusions

Applicants respectfully request:

- (1) entry of the amendments to the claims;
- (2) withdrawal of the objections to and rejections of the pending claims;
- (3) rejoinder of claims 7 to 16; and
- (4) allowance of claims 1 to 16.

If the Examiner wishes to discuss any aspect of the prosecution of the application, the Examiner is requested to contact the undersigned attorney at (404) 459-5642.

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